

09/966,023  
Art Unit 3693  
9084.00

#### REMARKS

This Amendment is submitted in response to the Office Action mailed on August 7, 2006. Claims 1 - 17 are pending, and all stand rejected at present. Claims 3 - 8 and 15 - 17 have been cancelled. Claims 18 - 26 have been added. No fee is due.

#### RESPONSE TO REJECTIONS

Claims 1 - 17 were rejected on grounds of anticipation, based on Slater.

#### SLATER NOT AVAILABLE AS REFERENCE

Slater is a pending US application. Slater's filing date is October 11, 2002. Applicant's US filing date precedes Slater's filing date, as does Applicant's UK filing date.

Slater does list an earlier filing date of a parent application, namely, February 9, 2000. However, Slater's pending US application is a continuation-in-part. By definition, Slater's pending US application contains material which was **absent** from the parent application.

It is not known whether that absent material is being relied on to reject Applicant's claims. If so, then the rejections are invalid, because the absent material cannot use the filing date of Slater's parent.

The PTO must show that the material in Slater, which is used

09/966,023  
Art Unit 3693  
9084.00

to reject Applicant's claims, can trace its origin to Slater's parent application. That has not been done.

Until that is done, Slater is not available as a reference.

#### CLAIM ELEMENTS MISSING FROM SLATER

##### Claim 1

Claim 1 recites:

1. (Currently amended) A method of providing financial transactions via a self-service terminal associated with an organization having individuals under its supervision, the method comprising the steps of:

maintaining a financial account for the organization;

maintaining a financial account for an individual under the supervision of the organization;

allowing a sponsor and/or the organization to establish rules governing use of funds within the financial account by the individual; and

when a transaction is requested by the individual at a self-service terminal located in premises used by the organization, examining the rules and fulfilling a the transaction

~~requested by the individual at a self-service terminal located in premises used by the organization~~

if the transaction is consistent with the established rules for that individual.

Three elements of the claim are relevant here.

09/966,023  
Art Unit 3693  
9084.00

- One is that the sponsor establishes rules for use of funds within the account.
- A second is that the rules are examined.
- A third is that a requested transaction is fulfilled if it is consistent with the rules.

For example, as Applicant's Specification explains on page 9 and elsewhere, if a student requests a meal ticket at times when meals are being served, the ticket is issued.

These three elements are missing from Slater.

#### Element 1

##### POINT 1

The Office Action asserts that item 16 in Slater's Figure 1, and Slater's paragraph 17, show the claimed "rules." However, as Slater's paragraph 22 explains, item 16 refers to an "implementation specialist" which assists in setting up Slater's system. In Slater's system, "value-added cards" (like credit cards) are issued to people instead of checks or cash. (See paragraph 16.)

Slater's paragraph 16 does state that the "implementation specialist" assures that government regulations are followed by Slater's system. But that does not correspond to the claimed "rules."

The claimed rules apply to usage of funds within the specific

09/966,023  
Art Unit 3693  
9084.00

account of the individual. That has not been shown in Slater.

## POINT 2

The Office Action asserts that Slater, in paragraph 17, states that the value-added card can replace a payroll check. The Office Action asserts this to be an example of a "rule."

Applicant points out several problems in this assertion.

One problem is that, in point of fact, neither a value-added card, nor a payroll check, is a "rule."

A second problem is that the claim states that the "rules" are examined, and examined at a specific time, namely, when a transaction is requested. Slater does not show that, nor does he show examination of the paycheck/card.

A third problem is that the claim states that the transaction is allowed if the rules allow it. That is not seen in Slater.

Therefore, the paycheck/card in Slater does not show the claimed "rules," nor the use of them as claimed.

## Element 2

The claim states that the rules are examined. That is not seen in Slater.

## Element 3

The Office Action cites Slater's paragraph 53 as showing the

09/966,023  
Art Unit 3693  
9084.00

last paragraph of the claim. In paragraph 53, Slater discusses a college student who is issued a credit card, and who uses the credit card to purchase items needed for school.

Slater does state that a limitation may be imposed, namely, that the credit card can only be used at merchants which sell school supplies. But that does not show the claimed recitation, which refers to a "transaction" at a "self-service terminal" (SST), during which "rules" are examined.

Further, the claim states that the SST is located on the "premises." The Office Action asserts that it is "inherent" that the merchants in Slater are so located.

MPEP § 2112 states:

EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE  
TENDING TO SHOW INHERENCY.

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

The Office Action has not set forth the required "basis in fact and/or technical reasoning" in support of its conclusion of inherency.

Further, the undersigned attorney has attended several universities. At some of them, merchants were present, which were located off university property, which sold books and supplies.

09/966,023  
Art Unit 3693  
9084.00

That fact is directly contrary to the PTO's conclusion of inherency.

Additional Point 1

The rejection is inconsistent. On the one hand, it relies on the value-added card in Slater's paragraph 17, which is substituted for a paycheck, as showing the claimed "rule."

On the other hand, it relies on the limitation on merchants in Slater's paragraph 53 as showing the claimed fulfillment of the transaction if the rules allow it.

Those are two **different** elements in Slater, being used to show the **same** "rule" in the claim.

The rejection must rely on the **same element** in Slater to show the "rules" throughout the claim. MPEP § 2131 states:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

The inconsistency fails to comply with this MPEP section.

Further, the claim states that the "rules" are examined. If that is to be found in Slater, then rules governing the claimed "funds within the financial account" are found in the value-added card of Slater. (Because the latter card is said to be a "rule.") That is simply not so.

09/966,023  
Art Unit 3693  
9084.00

#### **Independent Claims 9 and 12**

The discussion above applies to claims 9 and 12.

In addition, Applicant points out that these claims state that the rules are available to the terminal (SST or ATM) or its host. That is not seen in Slater.

#### **Added Claims**

Claims 18 - 20 states that the rules limit times-of-day of transactions. That is not seen in Slater.

Claims 21 - 23 state that a non-authorization message is displayed if non-compliance with a rule is detected. That is not seen in Slater.

Claim 24 states that rules are established, and different accounts have different rules. That is not seen in Slater.

Claim 24 states that ATMs, or their hosts, have access to the rules and accounts. That is not seen in Slater.

Claim 24 states that, when a transaction is requested at an ATM, the rules are consulted. That is not seen, nor is the claimed rejection message.

Claim 25 recites limits on times-of-day. That is not seen in Slater.

Claim 26 states that different rules are established for different individuals. That is not seen in Slater.


09/966,023  
Art Unit 3693  
9084.00

**CONCLUSION**

Applicant requests that the rejections to the claims be reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful consideration given to this case.

Respectfully submitted,

  
Gregory A. Welte  
Reg. No. 30,434

NCR Corporation  
1700 South Patterson Blvd.  
WHQ - 5  
Dayton, OH 45479  
November 7, 2006  
(937) 445 - 4956